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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/997,915 | 11/29/2001 | Bhupesh Gupta | AUS920010888US1 | 6707 |

7590

08/31/2004

Mr. Volel Emile
P.O. Box 202170
Austin, TX 78720-2170

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| EXAMINER |
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SAIN, GAUTAM

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| ART UNIT | PAPER NUMBER |
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2176

DATE MAILED: 08/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/997,915

Applicant(s)

GUPTA, BHUPESH

Examiner

Gautam Sain

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/29/01.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

- 1) 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

- 1-1) Claims 1-8, 17-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claims 1-8, 17-24 set forth non-functional descriptive material but fail to set forth physical structures or materials comprising of hardware or a combination of hardware and software within the technological arts (ie., a computer) to produce a “useful, concrete and tangible” result. For example, claims 1 and 8, the “method” and “apparatus” reads on a mental construct/abstract idea or at best a computer program program per se. The language such as “categorizing”, “bookmarking”, “web page”, etc., does not clearly define structural elements and are not tangibly embodied on a computer readable medium. Claims 1-8, 17-24 are interpreted as software per se, abstract ideas or mental construct and not tangibly embodied computer readable medium or hardware.

Claim Rejections - 35 USC § 102

- 2) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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2-1) Claims 1-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Burke (US 6032162, issued Feb 29, 2000).

Regarding claims 1, 9, 17, 25, Burke teaches determining ... on a server (ie., URL file to identify HTML tags for type indicators to see if it belongs to previously stored category)(col 4, line 65 – col 5, lines 20).

Burke teaches downloading ... a category (ie., bookmarks previously stored ... sub-category of topics ... stock prices ...)(col 5, lines 8-24; col 7, lines 10-15).

Burke teaches creating ... name (ie., bookmarks categorized by theme/topic under master set of themes/topics)(col 5, lines 8-24).

Burke teaches storing ... sub-folder (ie., collates and merges set of bookmarks)(col 5, lines 8-24).

Regarding claims 2, 10, 18, 26, Burke teaches determining ... creating the sub-folder (ie., determining if previously stored file of bookmarks does not exists, then controller creates a file)(col 5, lines 54-60).

Regarding claim 3, 11, 19, 27, Burke teaches if there already ... not created (ie., controller collates in designated files – which encompass sub-categories)(col 5, lines 8-20).

Regarding claims 4, 12, 20, 28, Burke teaches if the Web page ... sub-folder (ie., for a file where a bookmark does not exist, the controller stores the collated non-merged bookmarks in the created file with only user identification information)(col 5, lines 54-61).

Regarding claims 5, 13, 21, 29, Burke teaches if the Web page ... assigned a category (ie., user can select and transfer data from bookmarks stored in the downloaded system which is requested by the user using the URL and the system returns the file and corresponding information)(col 6, lines 15-23).

Regarding claims 6, 14, 22, 30, Burke teaches after web page has been assigned a category ... default sub-folder (ie., the downloaded bookmark has a theme or topic which is more than the default useid and password file)(col 5, lines 10-20; lines 54-60).

Regarding claims 7, 15, 23, 31, Burke teaches determining ... creating the sub-folder (ie., determining if previously stored file of bookmarks does not exists, then controller creates a file)(col 5, lines 54-60).

Regarding claims 8, 16, 24, 32, Burke teaches if there already ... existed sub-folder (ie., previously stored file with theme and topic)(col 5, lines 8-20).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gautam Sain whose telephone number is 703-305-8777. The examiner can normally be reached on M-F 9-5 EST.

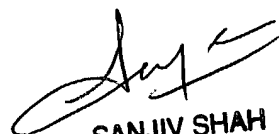
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (703)305-9792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GS

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SANJIV SHAH
PRIMARY EXAMINER

Best Available Copy